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TO: Mail Stop Petition
DATE: 3/10/04
FROM: J. Gamberdell
RE: 10/017, 113

FAX NO: 703-872-9306

P&G Reference: 871-011413-45 (P&G)

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MAR 10 2004

OFFICIAL

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT[s]: Agilent Technologies UK Limited on behalf of
David Chown, inventor

SERIAL NO.: 10/617,113 ART UNIT:

FILING DATE: July 10, 2003 EXAMINER:

TITLE: Optoelectronic Module with Integrated Loop-
Back Capability

ATTORNEY

DOCKET NO.: 871-011413-US (PAR) / 30020606 US-02

Mail Stop Petition
Commissioner of Patents
P.O. Box 1450
Alexandria VA 22313-1450

REQUEST FOR RECONSIDERATION OF PETITION UNDER

37 C.F.R. 1.47(b)

In response to the decision mailed on 13 January 2004, dismissing the petition filed on 5 September 2003, Applicant, Agilent Technologies UK Limited, hereby again petitions the Commissioner to accept the filing of the above-identified U.S. Patent Application by the Applicant.

The Applicant construes the sole inventor's conduct as a constructive refusal to join in the application.

A grantable petition under 37 CFR §1.47(b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that diligent efforts have been made to locate

the no-signing inventor;

(5) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;

(6) proof of irreparable damage, and;

(7) an acceptable oath or declaration in compliance with 35 USC §§ 115 and 116 and 37 CFR §1.63.

The decision mailed on 13 January 2004 found deficiencies with items (4), (5), and (7).

Item (4)

Applicant submits that item (4) above is satisfied by Exhibits 1-4 of the Statement of Facts previously submitted.

The last known address of the inventor is:

Mr. David Chown
9 Castle Lane
Hadleigh, Ipswich, Suffolk IP7 6DE
United Kingdom

Exhibit 1 is a copy of a first cover letter to Mr. David Chown, dated 4 June 2003 and sent to the last known address, stating that a Declaration, Assignment, and copy of the application are enclosed, and requesting Mr. Chown's signature on the appropriate documents.

Exhibit 2 shows a copy of a two page letter from the Royal Mail to Ms. Pauline Jones confirming that the letter was delivered and on the second page, showing a Receipt for Certified Mail with a delivery date of 6 June 2003 and a copy of Mr. Chown's signature.

Exhibit 3 shows a copy of the second cover letter to Mr. David Chown, dated 31 July 2003, stating that a Declaration, Assignment, and copy of the application are enclosed, and requesting Mr. Chown's signature on the appropriate documents.

Exhibit 4 shows a copy of the second Receipt for Certified Mail showing a delivery date of 7 August 2003 and Mr. Chown's signature.

Because the inventor was presented on two occasions with the application papers and a request to sign, and each time the inventor signed the Receipt for Certified Mail, but the inventor has not yet returned the signed papers, the Applicant construes the inventor's behavior as a constructive refusal to join in the application.

Item (5)

Applicant submits that item (5) above is satisfied by Exhibit 5 of the Statement of Facts previously submitted and by paragraph 4 of that Statement of Facts.

Exhibit 5 shows a copy of an Employee Confidentiality Agreement dated 20 December 2000 and signed by Mr. David Chown confirming that ownership of all intellectual property rights (including patents) arising out of work carried out by Mr. Chown during the course of his employment with Agilent Technologies shall belong to Agilent Technologies.


Paragraph 4 is a statement made by Dr. James Lenney that the invention was made by the inventor while in the employ of the Applicant.

Item (7)

To satisfy item (7), Applicant submits a declaration signed by Dr. James Lenney, on behalf of the Applicant. In compliance with MPEP 409.03(b), Dr. James Lenney states that he is authorized to sign on behalf of Agilent Technologies UK Limited, and his title of Patent Attorney is specified.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


Joseph V. Gamberdelli, Jr.
Reg. No. 44,695

10 March 2004
Date

Perman & Green, LLP
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Fairfield, CT 06824
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted by facsimile to 703-372-9306 the date indicated below, addressed to the Mail Stop Petition, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date: 3/10/04

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